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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,660	04/08/2004	John G. Almlti	AMS-040A	8025
40636 7590 04/25/2008 AMS RESEARCH CORPORATION 10700 BREN ROAD WEST MINNETONKA, MN 55343				
EXAMINER				
BERTHEAUD, PETER JOHN				
ART UNIT		PAPER NUMBER		
3746				
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04/25/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/820,660

## Applicant(s)

ALMLI ET AL.

## Examiner

PETER J. BERTHEAUD

## Art Unit

3746

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 34-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 34-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This Office Action is in response to amendments filed 3/26/2008. It is noted that claim 34 has been amended.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 34 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 34 states that "the valve block includes a periphery with opposing surfaces, and wherein upon any of said opposing surface of said valve being compressed said inflatable prosthesis is deflated." However, only two of the panels may be compressed in order to cause deflation, and they are not opposing. Panel 35 is not able to be compressed, and panel 50, when compressed alone, does not cause deflation. Either panel 45 or 120 needs to be compressed in order to cause deflation, and these panels are perpendicular to one another, which the Examiner does not consider to be truly opposing. Examiner believes that the term "opposing" lends itself more to surfaces which are parallel to one another. Therefore, it is not true that if *any* of the opposing surfaces are compressed deflation is caused.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 34, and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Burton 5,141,509.

Regarding claim 1 (as well as disclosure pertinent to the rejection of claims 2-13):

Burton (Burton, Fig. 1) discloses a penile prosthesis having means for preventing spontaneous inflation comprising: a housing 40 having an outer wall with at least a portion of the outer wall being compressible (see 42, 44); a first flow valve 14 (see specifically the inclined section between 16 and 18) positioned within the housing and having a seated and an unseated position; and a bar 16, 18 positioned within the housing and moveable between a first and a second position so that when the bar 16 is moved from the first position to the second position the bar causes the first flow valve 14 to move from the seated to the unseated position. Burton further discloses (claim 2) a first compressible side wall 42 positioned to intersect an axis defined by a path of travel of the first flow valve 14; (claim 3) wherein the housing has a substantially rectangular configuration. Burton further discloses (claim 5) that an obtuse interior angle is formed between the first portion of the bar 16 and the second portion of the bar 18 (see angle between 16 and the inclined section of 18). Burton also discloses (claim 13)

a second flow valve 24 positioned such that when the first flow valve 14 is moved from the seated to the unseated position, the first flow valve 14 contacts the second flow valve 24 and moves the second flow valve 24 from a seated to an unseated position (see Fig. 3).

Regarding claim 34:

In light of the above 112 rejection: as best as can be applied by Examiner, Burton discloses a penile prosthesis having means for preventing spontaneous inflation comprising: a valve block 20 and a shell 40 attached to the valve block wherein the shell includes a pump bulb 10; and wherein the valve block includes a periphery with opposing surfaces, and wherein upon any of said opposing surface of said valve being compressed said inflatable prosthesis is deflated (surface 42 and the rounded corner below it may be compressed in a certain way so as to cause deflation).

Regarding claim 35-45:

Burton (Burton, Fig. 1) discloses a penile prosthesis having means for preventing spontaneous inflation comprising: a housing 40 having an outer wall with at least a portion of the outer wall being compressible (see 42,44); a first flow valve 14 (see specifically the inclined section between 16 and 18) positioned within the housing and having a seated and an unseated position; and a bar 16, 18 positioned within the housing, the bar comprising a spring 22 and being moveable between a first and a second position so that when the bar is moved from the first position to the second position the bar causes the first flow valve 14 to move from the seated to the unseated position. Burton further discloses (claim 36) the bar has a bend (see bend to and from

inclined surface on 14) connecting a first portion 16 and a second portion 18 of the bar, at least one rib (see middle of 14) extending the first and second portions of the bar such that the bend augments the spring (see how the middle of 14 augments spring 22), the outer wall further comprising: a first compressible side wall 42 positioned to intersect an axis defined by a path of travel of the first flow valve 14 from the seated to the unseated position. Burton further discloses (claim 37) that the bar is a thin elongate member, an end portion of the second portion 18 of the bar engaging an end of the first flow valve (see flat side of middle section of 14) when the bar is in the first position. Burton also discloses (claim 39) the at least one rib (see middle of 14) extending across the bend is shaped to as to make the bar stiff, such that resistance to deflection forces is enhanced; and wherein (claim 40) the first portion of the bar comprises at least one rib (see middle portion of 14) centrally located on thereon, such that the when the first portion of the bar is compressed by the first compressible side wall compression forces exerted on the first portion of the bar are distributed substantially evenly along the first portion of the bar. Burton further discloses (claims 43-44) a support member 20 coupled to the housing 40, wherein the support member 20 contacts a portion of the first flow valve 14 in such as manner as to prevent sideways movement of the first flow valve; wherein the support member 20 further comprises a shelf (see valve seat for 14) in contact with the first flow valve 14. Burton also discloses (claim 45) a second flow valve 24 positioned such that when the first flow valve 14 is moved from the seated to the unseated position, the first flow valve 14 contacts the second flow valve 24 and moves the second flow valve 24 from a seated to an unseated position (see Fig. 3).

Furthermore, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, because apparatus claims cover what a device is, not what a device does (Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)). Thus, if a prior art structure is capable of performing the intended use as recited in the preamble, or elsewhere in a claim, then it meets the claim.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2, 3, 13, 36, 37, and 43-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burton 5,141,509 in view of Doyle 3,510,029.

Burton discloses the invention as discussed above. However, Burton does not teach the following claimed limitations taught by Doyle.

Doyle teaches a gas release apparatus comprising a housing 26, a bar 16 used to open a valve (see col. 2, lines 9-14) with a first compressible side wall 48 positioned to intersect an axis defined by a path of travel of the first flow valve (see bar 16) from the seated to the unseated position; a second compressible side wall 46 adjacent to the first compressible side wall 48, located such that a first portion of the bar is adjacent to the first compressible side wall 48 and a second portion of the bar is adjacent to the

second compressible side wall 44 so that if either the first or the second compressible side wall is compressed, the bar 16 is caused to engage the first flow valve and move the first flow valve from the seated to the unseated position (see col. 3, lines 6-12); wherein the first compressible side wall 48 is shorter than the second compressible side wall 44.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the valve assembly of Burton, by implementing a plurality of compressible side walls coupled to a valve in order to make it easier for the user to actuate the release valve.

8. Claims 4, 5, 38, 39, 40 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burton 5,141,509 in view of Doyle 3,510,029, and in further view of Smye 2,586,575.

Burton in view of Doyle discloses the invention as discussed above. However, Burton in view of Doyle does not teach the following claimed limitations taught by Smye.

Smye teaches a relief valve apparatus comprising a housing 4, with a compressible wall 30 coupled to a valve 12. Smye further teaches a bar 18 that is substantially parallel with the compressible side wall 30 (see inner side of 30) when the side wall 30 is in an uncompressed state (see Fig. 1). Smye further teaches that a segment of the first flow valve 12 includes a plastic member 24 disposed thereon such that the bar 18 contacts the plastic member 24 when the bar is in the first position (see Fig. 2).



Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the valve assembly of Burton in view of Doyle, by making the second compressible side wall parallel with the second portion of the bar when in an uncompressed state in order to have room between the housing wall and inner components so the wall can compress.

9. Claims 6, 7, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burton 5,141,509 in view of Doyle 3,510,029, and in further view of Lambert 5,158,111.

Burton in view of Doyle discloses the invention as discussed above. However, Burton in view of Doyle does not teach the following claimed limitations taught by Lambert.

Lambert (Fig. 7) teaches a valve assembly comprising a bar 111, 109 and a valve 107. Lambert further discloses that the bar includes plastic and stainless steel (see col. 5, lines 14-16). Lambert also teaches (claim 41) that the flow valve 105 comprises a metal portion 111 and a synthetic portion 107.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the valve assembly of Burton in view of Doyle, by implementing a valve and or valve bar which incorporates both steel and plastic in order to give the valve assembly stability as well as good sealing quality.

10. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burton 5,141,509 in view of Doyle 3,510,029, and in further view of Valentine 3,228,731.

Burton in view of Doyle discloses the invention as discussed above. However, Burton in view of Doyle does not teach the following claimed limitations taught by Valentine.

Valentine teaches a valve assembly comprising valve bar member 38. Valentine further teaches wherein the first portion of the bar (top end of 38) includes a curved free end wherein a curvature of the free end operatively associates with a curvature of the first flow valve (see cover over 38 that provides valve 36); wherein a curvature of the free end also operatively associates with a curvature of an interior portion of the outer wall (see wall above chamber 12).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the valve assembly of Burton in view of Doyle, by implementing a valve bar with a curved free end that operatively associates with an outer wall in order to allow the valve to reciprocate easily within the housing.

11. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Burton 5,141,509 in view of Doyle 3,510,029, and in further view of Willard 6,171,233.

Burton in view of Doyle discloses the invention as discussed above. However, Burton in view of Doyle does not teach the following claimed limitations taught by Willard.

Willard (Fig. 1) teaches a penile pump assembly comprising a pump bulb 18 coupled to a housing 20, wherein the pump bulb 18 has a first exterior texture and the housing 20 has a second exterior texture that is different than the first exterior texture (see Fig. 1).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the pump assembly of Burton in view of Doyle, by implementing a pump bulb and housing with various textures in order to allow the user to better grip the elements.

12. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burton 5,141,509 in view of Doyle 3,510,029, and in further view of Keefe 5,328,293.

Burton in view of Doyle discloses the invention as discussed above. However, Burton in view of Doyle does not teach the following claimed limitations taught by Keefe.

Keefe discloses a tactile tile comprising a texture including a plurality of raised circular panels 8. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the pump assembly of Burton in view of Doyle, by implementing a texture on the housing that includes a plurality of circular raised panels in order to allow the user to gain a better grip on the housing (Keefe, col. 2, lines 12-17).

#### ***Response to Arguments***

13. Applicant's arguments filed 3/26/2008 have been fully considered but they are not persuasive.

14. In response to Applicant's arguments with respect to claim 1: Applicant argues that Burton does not show the claimed element of the bar, and that if 16 and 18 were deemed to be a bar then Burton would no longer have a valve. Examiner respectfully disagrees. It is a reasonable interpretation to consider just the tapered portion of

element 14 as the valve, because it is the part which is actually allowing fluid to pass. Furthermore, elements 16 and 18 in combination can most certainly be considered a bar, which the valve just happens to be attached to, due to the term "bar" being sufficiently broad. In response to Applicant's argument that that the valve becomes unseated not through movement of a bar but through the squeezing of deformable surfaces 42 and 44. Examiner again disagrees. It is clearly shown in figure 3 that the valve is unseated by movement of the bar 16, 18. It is true that this is done via squeezing of the deformable surfaces, but the valve will not move if the bar 16, 18 does not move. Therefore, Burton still reads on the current invention *as claimed*.

15. Applicant's arguments with respect to claim 34 have been considered but are moot in view of the new ground(s) of rejection.

16. In response to Applicant's arguments with respect to claim 35: Applicant argues that Burton does not teach "a bar comprising a spring" (language as claimed). Examiner respectfully disagrees. The bar 16, 18 in Burton is coupled to the spring 22; thus it is reasonable to interpret the bar 16, 18 as comprising the spring 22. The language that "the bar comprises a spring" is sufficiently broad, and Burton reads on it *as claimed*.

### ***Conclusion***

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PETER J. BERTHEAUD whose telephone number is (571)272-3476. The examiner can normally be reached on M-F 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Devon Kramer can be reached on (571) 272-7118. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3746

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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